REMARKS

<u>Office Action</u>

In the Office Action mailed on September 12, 2008, the Examiner rejected

claims 1 and 8 under 35 U.S.C. 112, first paragraph and second paragraph

because of ambiguity arising from the phrase "generating device independent

color space data from grayscale data that corresponds to the selected highlight."

For purposes of examination, the Examiner assumed that the grayscale data

corresponded to the selected highlight.

The Examiner also rejected claims 1, 2, 8, and 9 under 35 U.S.C. 103(a)

as being unpatentable over U.S. Patent Number 5,050,984 to Geshwind

(hereinafter "Geshwind") in view of U.S. Patent Number 6,058,207 to Tuijn et al.

(hereinafter "Tuijn"). Claims 3 and 10 were rejected under 35 U.S.C. 103(a) as

being unpatentable over Geshwind in view of Tuijn and in further view of U.S.

Patent Number 6,775,408 to Masaki (hereinafter "Masaki"). Claims 4-7 and 11-16

were rejected under 35 U.S.C. 103(a) as being unpatentable over Geshwind in

view of Tuijn and in further view of U.S. Patent Number 6,225,974 to Marsden et

al. (hereinafter "Marsden").

<u>Claim Rejections</u>

<u>Section 112 Ground of Rejection</u>

Claims 1 and 8

Claims 1 and 8 have been amended to remove the perceived ambiguity so

the phrase "corresponding to the selected highlight" unambiguously refers to the

device independent color space data, which the Examiner admits is taught by

Applicant's specification. *Office Action*, p. 2, lines 17-18. Therefore, Applicant

submits that the section 112 ground of rejection is now moot.

Section 103 Ground of Rejection

Claims 1, 2, 8, and 9

Claim 1 requires the generation of "device independent color space data

from grayscale data, the device independent color space data corresponding to

the selected highlight." Neither Geshwind nor Tuijn discloses or suggests this

limitation, either alone or in combination.

In the Office Action, the Examiner asserted that Tuijn discloses a method

of generating device independent color space data from grayscale data that

corresponds to a selected highlight. *Office Action*, p. 4, lines 1-3. Applicant

respectfully disagrees. The method of Tuijn begins with color image data, *Tuijn*,

col. 6, lines 38-56, that may be identified with device dependent color space

coordinates, such as CMYK axes, *Tuijn*, col. 6, lines 57-67, or RGB coordinates,

Tuijn, col. 7, lines 13-16. A color is selected and this selected color is modified to

make it appear as a changed color. *Tuijn*, col. 6, lines 19-24. Color values for the

selected color in the RGB color space may be converted to a HSL (hue,

saturation, lightness) color space. As part of this conversion, the operator may

select a weighting function for a hue angle difference and another weighting

function for a saturation difference. *Tuijn*, col. 6, line 66 to col. 7, line 18. Tuijn

also indicates that these *color* space data may be expressed in a device

independent color space. *Tuijn*, col. 7, lines 19-31. In short, Tuijn teaches a method of converting data from one color space to data in another color space. The method enables the operator to convert between different device dependent color spaces or between different device independent color spaces in accordance with the operator's preferences. *Tuijn*, col. 7, lines 39-55. In short, the method disclosed in Tuijn fails to disclose the generation of any color space data from grayscale data. In fact, the word "grayscale" is never used in Tuijn. Similarly, no such teaching is found in Geshwind. *See Office Action*, p. 3, last paragraph.

Not only does Tuijn fail to provide any teachings regarding the conversion of grayscale data, it also does not suggest the generation of device independent color space data that corresponds to a selected highlight from grayscale data. As described in Applicant's specification, a highlight refers to a color that is produced with one colored ink and black ink or two colored inks and black ink. *Specification*, p. 1, lines 13-16. None of the references of record teach or suggest the generation of device independent color space data that corresponds to a selected highlight, that is, a color produced by one or two colored inks and black ink. Certainly, none of the references, either alone or in combination, teach the generation of such data from grayscale data. For at least these reasons, claim 1 is patentable over all references of record.

Because the limitation of generating device independent color space data that corresponds to a selected highlight from grayscale data is not disclosed in either reference used in support of the section 103 ground of rejection, the

rejection of claim 1 has been overcome. Claim 8 contains a similar limitation and, thus, claim 8 is also patentable over all references of record, either alone or in combination. Claims 2 and 9 depend from claims 1 and 8, respectively. Consequently, they also include this limitation and they are likewise patentable over all references of record for similar reasons.

Claims 3 and 10

Claims 3 and 10 depend from claims 1 and 8, respectively. Consequently, they also include the limitation discussed above with reference to those claims and they are likewise patentable over all references of record for similar reasons. Moreover, Masaki does not address or even mention grayscale data. The file selection portion cited by the Examiner in the Office Action refers to color image files and not grayscale data files. *See Masaki*, col. 3, lines 15-30. Therefore, Masaki cannot remedy the inadequately supported section 103 ground of rejection.

Claims 4-7 and 11-16

Claims 4-7 and 11-16 depend from claims 1 and 8, respectively, either directly or indirectly. Consequently, they also include the limitation discussed above with reference to those claims and they are likewise patentable over all references of record for similar reasons. Moreover, Marsden does not address or even mention grayscale data and the Examiner has cited no such teaching in

Marsden. Therefore, Marsden also fails to support the section 103 ground of

rejection.

Conclusion

For the reasons set forth above, all of the pending claims are patentable

over all references of record, either alone or in combination. Reexamination and

allowance of all pending claims are earnestly solicited.

Respectfully submitted,
MAGINOT, MOORE & BECK LLP

/David M. Lockman/
David M. Lockman
Attorney for Applicant
Registration No. 34,214

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Maginot, Moore & Beck LLP
Chase Tower
111 Monument Circle, Suite 3250
Indianapolis, Indiana 46204-5109
(317) 638-2922 Telephone
(317) 638-2139 Facsimile